UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Taylor

Mailed: June 2, 2006

Opposition No. **91122000**

AMAZON.COM, INC.

v.

VON ERIC LERNER KALAYDJIAN

Before Seeherman, Bucher and Cataldo,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of (1) opposer's motion to amend the notice of opposition and (2) opposer's "renewed" motion for summary judgment, both filed February 14, 2006.

Turning first to the motion to amend, opposer seeks to amend its notice of opposition to include allegations that reflect the following: 1) the issuance of registrations for trademark applications pleaded in opposer's notice of opposition; 2) the issuance of notices of allowance for trademark applications pleaded in opposer's notice of opposition; 3) six additional registrations for marks comprising or incorporating the term "Amazon" that issued after opposer filed its notice of opposition; and 4) additional assertions concerning the use of opposer's marks

in connection with the sale, distribution and promotion of products related to health and beauty. Opposer further seeks to amend the notice of opposition to remove references to opposer's trademark applications that are no longer under consideration for registration by the USPTO and to withdraw the cause of action for trademark dilution.

Opposer contends that the amended notice of opposition will cause no prejudice to applicant because the amended notice presents no new cause of action or legal theory, but merely updates the notice of opposition to reference trademark registrations that issued after the notice was filed, and includes assertions of additional facts that clarify opposer's claims. Opposer also contends that, prior to the filing of this motion, applicant had notice of opposer's argument that the AMAZON.COM marks are used on products related to health and beauty that are competitive with and/or related to the goods and services described in applicant's involved application. Because the parties have not taken testimony or submitted trial briefs in this matter, opposer argues that applicant will have the opportunity to present facts or evidence which he would have offered had the amendments been made earlier; and that if the Board were to find that opposer's delay in bringing the motion threatens any prejudice to applicant, such prejudice could be cured by reopening discovery to allow applicant

further opportunity to investigate the new facts alleged in the amended notice.

Opposer also argues that although the proceeding has been pending for five years, it was suspended for over half of this time pending the outcome of litigation between the parties, and that judicial economy is served by the present motion, as opposed to opposer's filing dozens of motions to amend the pleadings to address the changing status of each of opposer's trademark applications that was pending at the time opposer filed its notice of opposition.

Opposer therefore maintains that its motion to amend should be granted.

On February 21, 2006, applicant filed a response to the motion to amend. It is noted that the response was not served on opposer as required by Trademark Rule 2.119.[1] Generally, the Board would require applicant to serve its response on counsel for opposer prior to our consideration

[1] Applicant is once again reminded that Trademark Rule 2.119 requires that a party filing any paper with the Board during the course of a proceeding must serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. With the paper that is filed with the Board, the party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service. Applicant is advised that future filings that have not been served on counsel for opposer **will not** be considered. Additionally, all future filings should be captioned as this order is.

of it. However, because our decision would be the same if opposer were allowed further briefing in this matter, to prevent further delay in this case we have considered applicant's arguments and hereby render our decision prior to opposer's receiving applicant's response and perhaps filing a reply brief.[2]

In his response, applicant argues that opposer's proposed amendment to the notice of opposition is not timely, in that the discovery period closed on December 22, 2005; that any more discovery "to opposer" would be prejudicial to applicant; and that opposer had over five years to prepare "discovery for this opposition" yet, after discovery has closed, opposer wants more discovery.

It is well settled that amendments to pleadings should be allowed with great liberality at any stage of the proceeding where entry of the amendment would serve to further the end of justice, unless the amendment would violate settled law or be prejudicial to the rights of the opposing party. *See Anheuser-Busch, Incorporated v. Martinez*, 185 USPQ 434 (TTAB 1975).

Moreover, the timing of a motion for leave to amend under Rule 15(a) plays a large role in the Board's

[2] Consideration of reply briefs is discretionary with the Board. Trademark Rule 2.127(a).
A copy of applicant's response is included with opposer's copy of this order.

determination of whether an adverse party would be prejudiced by allowance of the proposed amendment. *See Commodore Electronic Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ 1503 (TTAB 1993)(no prejudice to applicant, since discovery still open when motion filed and opposer agreed to allow applicant further time for follow-up discovery on new claim); and *United States Olympic Committee v. O-M Bread, Inc.*, 26 USPQ2d 1221 (TTAB 1993)(applicant would not be prejudiced because proceeding still in pretrial stage and discovery had been extended).

Applicant's primary objection to amendment of the notice of opposition is timing, the motion to amend having been filed after the close of discovery and five years after this proceeding commenced. Applicant is particularly concerned that any additional discovery for opposer would be prejudicial to applicant. However, although five years have passed since the filing of the original notice of opposition, for much of that time the opposition was suspended pending resolution of a civil action between the parties and for decision on a motion to compel and motion for summary judgment filed in this proceeding. During such a suspension, no motion to amend could have been filed. Additionally, all of the registrations sought to be added to opposer's pleading issued after the filing date of the

original notice of opposition. Thus, we find that opposer did not unduly delay in filing its motion to amend.

We further find that applicant would not be prejudiced by any reopening of the discovery period. Opposer indicates that it consents to the reopening of discovery for the sole benefit of applicant and, in fact, discovery would be reopened for applicant only, for the purpose of conducting discovery on the new claims. Moreover, the testimony and briefing periods have not yet commenced.

In sum, we find opposer's motion to amend the notice of opposition timely and the circumstances appropriate for granting the motion. Accordingly, opposer's motion to amend the notice of opposition is granted and opposer's amended notice of opposition, filed February 14, 2006, is now opposer's operative pleading in this case.

Turning next to opposer's motion for summary judgment, we note that applicant's response was not served on counsel for opposer as required by Trademark Rule 2.119. As noted above, applicant must properly serve all papers on opposer, and in the future, any papers not bearing proper proof of service will not be considered. However, because we have not specifically advised applicant previously that we would take such action, we will consider the instant paper. Applicant's response is directed solely to what applicant perceives as a procedural defect regarding opposer's renewed

motion, not to the merits thereof. Specifically, applicant contends that opposer is "disrespecting the ttab decision of December 22, 2005" by filing another summary judgment motion based on likelihood of confusion. By this order, opposer's motion to amend the notice of opposition has been granted. Because opposer's renewed motion for summary judgment is one that includes those additional claims, opposer's motion is proper. However, because applicant was not aware that these claims would be considered, since the amended notice of opposition had not been accepted at the time the second motion for summary was filed, we will give applicant an opportunity to respond to the motion for summary judgment on the merits.

Applicant is allowed until **thirty days** from the mailing date of this order to file a response on the merits to opposer's renewed motion for summary judgment. We note that opposer's renewed motion states that it is on the grounds of likelihood of confusion and dilution. Inasmuch as opposer has deleted its dilution claim from the amended notice of opposition and because opposer, in arguing its renewed motion for summary judgment, did not discuss dilution, we consider opposer's renewed motion for summary judgment to be solely on the ground on likelihood of confusion, the only ground that remains in this opposition proceeding.

Consequently, applicant need only respond to the likelihood of confusion claim.

Proceedings herein remain otherwise suspended in accordance with the Board's February 23, 2006 order. Applicant will be allowed time to respond to the amended notice of opposition, and discovery and trial dates will be reset, if and when proceedings herein are resumed.

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